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EXAMINER
GUTIERREZ, D

ART UNIT	PAPER NUMBER
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DATE MAILED: 08/13/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ___ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☒ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☒ Claims 1-15 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-7, 9-15 are rejected.

5. ☒ Claims 8 are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.

13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

PTOL-326 (Rev. 2/93)

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

2. The drawings are objected to because Fig. 1 was not submitted. Applicant is also reminded that this figure should be labeled --Prior Art-- since the specification states that Fig. 1 illustrates a prior art radiometer with a sighting device. Correction is required.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1) and M.P.E.P. § 608.01(l). Correction of the following is required:

- The specification does not clearly indicate that the two lasers are positioned approximately 180 degrees apart as state din claims 9 and 15.

4. Claims 9-14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9: the claim language is confusing because it is not clearly indicated that one of the two lasers stated in this claim is the same as the "at least one laser" indicated in claim 1.

Claim 11: "the laser beams" in line 4 lacks antecedent basis.

5. Claims 1, 4-7, 9-15 are rejected under the judicially created doctrine of non-statutory double patenting as being unpatentable over claims 9-14 of U.S. Patent No. 5,368,392. The now claimed subject matter is described within the disclosure and encompassed within the scope of the claims of Applicant's U.S. Patent No. 5,368,392, and therefore, a claim for the now claimed subject matter could have been presented therein.

See particularly the description of Figs. 3 and 6 which

discloses the use of a rotating laser; the description of Fig. 8 which discloses the use of a motor to rotate the laser beam, thus "adjusting" or "calibrating" the position of the laser beam; the description of Fig. 7, particularly, column 7, lines 3-5 which discloses the use of two fibers, each carrying a laser beam and positioned 180 degrees apart; and the description in column 3, lines 45-47 which suggests the use of a dedicated laser for each laser beam used to outline the energy zone, i.e., two lasers.

6. The non-statutory type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term. See In re Schneller, 158 USPQ 210 (CCPA 1968). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

7. Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-14 of U.S. Patent No. 5,368,392.

Claims 9-14 of the US Patent claim a laser sighting device

including means for visibly positioning the laser beam about the energy zone to be measured. Claims 9-14 claim all the limitations stated in claims 1-3 of this application with the exception of how the laser sighting device is attached to the radiometer. However, how the laser sighting device is attached to the radiometer, i.e., removably mounted or integrally formed, absent any criticality, is only considered to be a choice of engineering skill or design since neither non-obvious nor unexpected results will be obtained as long as the laser sighting device is attached to the radiometer. Furthermore, the claims in the U.S. Patent indicate that the laser sighting device is used in conjunction with a radiometer, which implies to a person having ordinary skill in the art, that the radiometer and sighting device must be attached to each other in some way. Moreover, with respect to claim 3, the term "integrally" is sufficiently broad to embrace constructions united by such means as fastening and welding. See *In re Hotte,* 177 USPQ 326, 328 (CCPA 1973).

8. The obviousness-type double patenting rejection is a

judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

9. Applicant should note that the claims in this application may also be rejected under the judicially created doctrine of obviousness-type double patenting(similar to the rejection stated above in paragraph 7) and under the judicially created doctrine of non-statutory double patenting (similar to the rejection stated above in paragraph 5) as being unpatentable over claims 11-16 and 22-26 of U.S. Patent 5,524,984. However, this rejection is not necessary at this time since U.S. Patent 5,368,392, used in the obviousness-type and non-statutory double patenting rejections stated above in paragraphs 5 and 7, has an earlier date of publication (issue date).

10. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this

Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

11. Claims 1-3 are rejected under 35 U.S.C. § 103 as being unpatentable over Everest in view of Darringer et al.

Everest discloses an apparatus for identifying an energy zone on a surface whose temperature is to be measured wherein a

sighting device, integrally formed with a radiometer as shown in Fig. 2, uses a visible light source to identify the energy zone including the periphery thereof. Everest discloses all the subject matter claimed by applicant with the exception of the sighting device using a laser as the visible light source and the limitation stated in claim 2.

Darringer et al. discloses a sighting device for an infrared detector wherein a laser is used as the source of visible light. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a laser as taught by Darringer et al. as the visible source of light used by Everest since both are alternate types of sources of visible light which will provide the same function of providing a beam of visible light and since Everest has already suggested that any source of visible light may be used since the two sources of visible light identified by Everest are considered only examples of types of sources of visible light that may be used.

With respect to claim 2: how the sighting device is attached to the radiometer, i.e., removably mounted as claimed by applicant or integrally formed as shown by Everest, absent any criticality, is only considered to be a choice of engineering skill or design since neither non-obvious nor unexpected results will be obtained as long as the sighting device is attached to the radiometer.

12. Claims 1-3, 9, 10 and 15 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 62-12848 [hereinafter JP] in view of Darringer et al.

JP discloses an apparatus for identifying an energy zone on a surface whose temperature is to be measured wherein a sighting device uses a plurality of visible light sources 5, two of which are shown positioned approximately 180 degrees apart in Figs. 1 and 2, to identify the energy zone including the periphery thereof. JP discloses all the subject matter claimed by applicant with the exception of the sighting device using a laser as the visible light source and the limitation stated in claims 2

and 3.

Darringer et al. discloses a sighting device for an infrared detector wherein a laser is used as the source of visible light. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a laser as taught by Darringer et al. as the visible source of light used by JP since both are alternate types of sources of visible light which will provide the same function of providing a beam of visible light.

With respect to claims 2 and 3: JP's sighting device is used in conjunction with a radiometer 1. JP does not indicate the structural relationship between the radiometer and the sighting device. However, how the sighting device is attached to the radiometer, i.e., removably mounted or integrally formed, absent any criticality, is only considered to be a choice of engineering skill or design since neither non-obvious nor unexpected results will be obtained as long as the sighting device is used in conjunction with the radiometer to visible outline the energy

zone to be measured. Furthermore, with respect to claim 3, the term "integrally" is sufficiently broad to embrace constructions united by such means as fastening and welding. See *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973).

13. Claims 11-14 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and if a terminal disclaimer is timely filed.

14. Claims 4-7 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims and if a terminal disclaimer is timely filed.

15. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art cited in the PTO-892 and not mentioned above disclose related apparatus. Copies of the references cited with an "*" in the PTO-892 are not enclosed since they were already sent to applicant during the prosecution of the parent applications.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Gutierrez whose telephone number is (703) 308-3875.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

DIEGO F.F. GUTIERREZ
PRIMARY EXAMINER
GROUP ART UNIT 3108

DG
August 12, 1996